

**IN THE UNITED STATES PATENT AND TRADEMARK OFFICE
BEFORE THE BOARD OF PATENT APPEALS AND INTERFERENCES**

Application No. : 10/630,141
Applicant : John J. Giobbi
Filed : July 30, 2003
Title : Portable Data For Communicating With Gaming
Machine Over Wireless Link
TC/A.U. : 3714
Examiner : Jasson H. Yoo
Docket No. : 247079-000107USD2
Customer No. : 70243

Mail Stop Appeals
Commissioner for Patents
P.O. Box 1450
Alexandria, Virginia 22313-1450

REPLY BRIEF

Dear Commissioner:

This Reply is filed in support to the Appellants' appeal to the Board of Patent Appeals and Interferences ("Board") from the final rejection of claims 101-104 and 106-125 in the April 28, 2009 Final Office Action. (Exhibit B¹). An Answer Brief from the Examiner was filed on September 30, 2009. The due date for this Reply Brief is two months from the mailing date of the Examiner Answer and this Reply is being timely filed.

ARGUMENT

In the initial Appeals Brief, Applicant argued that a) Hedrick should not be combined with Rantze and Sizer that are in the unrelated merchandising fields; b) Hedrick should not be combined with Rantze and Sizer because this combination would render Hedrick inoperable for its intended purpose; and c) the combination of Hedrick, Rantze and Sizer does not anticipate the element of "modifying the operation of the machine" in claims 101, 102, 112 and 120.

¹ This Reply Brief will reference exhibits from the original Appeals Brief

The primary reference, Hedrick, is from the gaming field and fails to disclose critical inventive features. The references relied upon to fill in these features, Rantze and Sizer, are drawn from the unrelated retail merchandizing field. As noted in the initial Brief, neither Rantze nor Sizer allows any information exchange between a customer and the respective machines for the purpose of effecting machine operation associated with the individual. The combination of Rantze and Sizer with Hedrick would change the fundamental operation of Hedrick and therefore is another factor that argues against the combination.

A. The Inability To Combine References Physically Should Be Factored In A Lack Of Suggestion to Combine to One of Ordinary Skill In the Art.

The initial Brief argued that one of ordinary skill would not combine different detection schemes in Hedrick and Rantze/Sizer together as the capabilities for each are not compatible. The Answer has erroneously stated that “the test for obviousness is not whether the features of a secondary reference may be bodily incorporated into the structure of the primary reference ... Rather, the test is what the combined teachings of the references would have suggested to those of ordinary skill in the art.” (pp. 21-22). The Answer continues to misinterpret Applicant’s arguments as to the impropriety of combining Rantze/Sizer with Hedrick. Applicant has noted that since Rantze/Sizer and Hedrick differ in respective operations and purposes, one of ordinary skill would not have inferred the different elements of the claims by the combined teachings of the references. It is improper to simply pick and choose features from different references to satisfy all of the elements of a claim if the references cannot be combined. One of the circumstances where combination is improper is because “the claimed combination cannot change the principle of operation of the primary reference or render the reference inoperable for its intended purpose.” MPEP 2145(III); *see also* MPEP 2143.01(V) (“If proposed modification

would render the prior art invention being modified unsatisfactory for its intended purpose, then there is no suggestion or motivation to make the proposed modification”).

The Answer has not refuted the contention in the initial Brief, that Rantze’s detection system is essentially a one-way detection system while Hedrick is neither a detection nor a proximity system, it is actually a communication system. One of ordinary skill would not substitute Rantze or Sizer’s types of detectors in Hedrick because Hedrick requires communication and the substitution of Rantze’s detection system would render the other functions of Hedrick inoperable as the detectors in Rantze or Sizer could not exchange communication of information with the wireless device carried by a player. As the Answer contends, the purpose of Hedrick is player tracking information (p. 25). MPEP 2145 (III) specifically prohibits this type of combination stating “however, the claimed combination cannot change the principle of operation of the primary reference or render the reference inoperable for its intended purpose.” The suggested substitution of a passive detection method in Rantze for a communication method would render Hedrick inoperable for the purpose of communication with the player wireless device. The Answer ignores the fundamental proposition that it cannot teach what the combination of references would teach if the initial combination is improper because it would change the principle of operation of the primary reference.

B. The Differences Between Types Of “Marketing” and “Services” Offered By Rantze/Sizer and The Gaming Machines in Hedrick Are A Factor Against Combining The References

The initial Brief articulated that one of ordinary skill would not look to the retail information merchandizing field for references such as Rantze and Sizer for application to the wagering game field of Hedrick. The Answer has asserted that Rantze is not relied on to teach exchanging information between a customer and the respective machines. (p. 18). The Answer

has asserted that Hedrick discloses exchanging information between a customer and a gaming machine citing Col. 5, l. 56 to Col. 6, l. 6, Col. 10, l. 45 to Col. 11, l. 5 and Col. 17, l. 44 to Col. 18, l. 2. (p. 18). However, these sections describe information being sent from the portable device such as player tracking information (Ex. C, Col. 6, ll. 57-66, Col. 17, ll. 44-51), gaming information (Col. 10, ll. 45-56). The information exchange in Hedrick is therefore the opposite of information in Rantze or Sizer as it is information from the player carried device to the machine, the player does not receive or comprehend such information. As explained in the initial Brief, Rantze and Sizer provide information directly to the assumed customer or anyone else within the area of the kiosk described in these references. Far from establishing that Hedrick and Rantze/Sizer are in the same technical field, the type of information and the exchange of such information described by the references show that they are in different fields. Rantze and Sizer broadcast information directly to all persons, while the information in Hedrick is derived from the player carried portable device. The player in Hedrick does not receive information in any tangible form. The information cited by the Answer demonstrates that Hedrick is in an entirely different field, one where information is received by the machine from another device as opposed to information being broadcast from the machine to all persons around the machine.

The Answer has further asserted that Hedrick is in the field of electronic gaming machines that provide entertainment services to a customer while Rantze provides product information services to a customer. (pp. 18-19 and 26). The Answer fails to respond to the fact that these are inherently different services, providing information as in Rantze and Sizer is not a service in the same vein as entertainment which a customer must purchase in Hedrick.

The Answer has also asserted that since Hedrick has an attract mode and Rantze also operates in the attract mode, both references are in the field of marketing. (p. 19). However, the field of marketing is too general to support the application of diverse references such as Rantze and Sizer directed toward any person in the vicinity to Hedrick which is targeted specifically to an identified individual for wagering gaming. The machine operations in Rantze/Sizer are not geared toward attracting the customers to operate the machines in exchange for payment. Further, the environments of Hedrick and Rantze/Sizer differ as explained in the initial Brief. Therefore, the fields of marketing in Hedrick differ significantly from the marketing intended by Rantze and Sizer.

C. The Combination of Hedrick, Rantze and Sizer Does Not Anticipate The Element Of “Modifying The Operation of the Machine” Based on The Individual In Claims 101, 102, 112 and 120

The initial Brief contended that the combination of Hedrick, Rantze and Sizer did not anticipate “modifying the operation of the machine” because the operational modes in Rantze and Sizer remain fixed on providing information. Further, the initial Brief further notes that claim 101 requires “changing the operation of the gaming terminal to a first mode associated with the individual or a second mode associated with the individual.” Similarly, claim 102, 112 and 120 require a first and second mode associated with the passerby.

The Answer on page 27 contends that Hedrick discloses a first mode associated with an individual (attract mode in Col. 12, ll. 23-20) and a second mode associated with the individual (tracking mode in Col. 17, l. 34 to Col. 18, l. 5). As explained above, Hedrick does not disclose modifying the operation of the machine between the two disclosed modes based on proximity since the second mode is a player tracking mode that is operated by inserting a tracking card or on detection of the portable wireless device and is not dependent on proximity. (Ex. C, Col. 17,

ll. 36-52). In fact the two disclosed modes may be run simultaneously in Hedrick as the tracking mode may operate while the attract mode is operated. Further, neither of these sections discloses changing the operation from the first mode to the second mode based on the player identity information as required by these claims. Hedrick therefore does not anticipate changing the mode based on proximity.

The combination of Rantze and Sizer with Hedrick's also would not have any correlation with the passerby since Rantze and Sizer relate to generic marketing messages and offering general information directed to all persons. The combination of these references would not teach associating the operation with the passerby or individual because there are many individual preferences and individual information could not be determined via the distance from the proximity detectors in Rantze and Sizer combined with the actual gaming machine operation of Hedrick.

The Answer also repeats the contention that Rantze and Sizer modify the operation of the machine because the message changes in Sizer. (p. 27). As explained above, the kiosks in Rantze and Sizer have only one operation, namely the broadcast of information. Changing the type of information broadcast to a passerby does not constitute a modification in the operation of the machine as the machine in Sizer continues the same operation, the broadcast of information. Thus, the combination of Hedrick with Rantze/Sizer would not anticipate this element and therefore these claims are allowable.

Conclusion

It is the Applicant's belief that all of the pending claims are in condition for allowance and action towards that end is respectfully requested.

Respectfully submitted,

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